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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,405	06/15/2000	Josephus Martinus Maria Van Gastel	PHN-17.489	9106

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,405

Applicant(s)

VAN GASTEL, JOSEPHUS
MARTINUS MARIA

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The applicant(s) amendment filed on 8/17/04 has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Claims 3 and 4 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons set forth in Office Action, dated 10/17/02. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement in the response filed on 8/17/04, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 3 and 4 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse based on the reply filed on 8/17/04.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 1, the phrase of “wherein...Y-direction” (lines 9-11) is new matter. With the emphasis on the term of “exclusively” (line 10), the specification and drawings as originally filed, do not provide support for the at least two placement heads on the Y-slide moving exclusively and simultaneously in the X-direction. The term of “exclusively” implies that the placement heads move exclusively, or only, in the X-direction, which means that the placement heads cannot move, or are excluded from moving, in any other direction.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the phrase of “wherein...Y-direction” (lines 9-11) is misleading, confusing rendering the scope of the claim as being vague and indefinite. The term of “exclusively” (line 10) implies that the placement heads move exclusively, or only, “in the X-direction” (line 10), yet this is in contradiction with the recitation that the placement heads are “independently drivable in a Y-direction” (line 11). Furthermore, the specification (at page 4, lines 22-24) explicitly states that the placement heads move along a Y-direction, which means that the

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disclosure contradicts with the recitation that “two placement heads arranged on said Y-slide move exclusively simultaneously in the X-direction”.

Claim Rejections - 35 USC § 102

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hata et al.

Hata discloses a machine comprising the following structure: a transport device (board transfer means 22 in Fig. 3); at least one feeder area (region above component supply table 28A in Fig. 2) with electrical components; a Y-slide (shown in Fig. 3) that is independently drivable in an X-direction (vertical direction of arrows in Fig. 3); and at least two placement heads (nozzles 33 on upper head section 31 and nozzles 33 on lower head section 31 in Fig. 3) on the Y-slide.

It is noted that the claimed “Y-slide” is read as the structure defining the pair of head positioning mechanisms 41 shown in Figure 3.

With respect to the “wherein...” clause (last 3 lines of Claim 1), each of the placement heads (upper and lower nozzles 33) of Hata arranged on the Y-slide (pair of head positioning mechanisms 41) move simultaneously in the X-direction (vertical direction of arrows in Fig. 3) and are independently drivable from one another in a Y-direction (horizontal arrows shown in Fig. 3). For example, for positioning of the components on the circuit board in only the X-direction, the placement heads arranged on the Y-slide would move only, or exclusively, in the X-direction. Therefore as best understood, Hata fully satisfies the “wherein...” clause.

Regarding Claim(s) 2, Hata shows a plurality of “Y-slides” (at least 4 pairs of head positioning mechanisms 41 in Fig. 1) integrally connected with each other, with each “Y-slide” having at least two placement heads and being independently drivable in the X-direction.

Response to Arguments

10. Applicant's arguments filed in the response dated 8/17/04 have been fully considered, but have not been deemed to found as persuasive.

In regards to the merits of Hata et al, the applicant believes that Hata does not teach that the at least two placement heads on the Y-slide are independently drivable in the Y-direction and move exclusively simultaneously in the X-direction.

The examiner most respectfully disagrees. The fact that Hata shows at least 4 different motors 47 and 56, which can operate independently from one another including the various directional arrows surrounding the head sections 31 (as shown in Fig. 3), clearly indicates that the at least two placement heads (nozzles 33 on upper head section 31 and nozzles 33 on lower head section 31 in Fig. 3) can move independently from, or simultaneously with, one another in the directions indicated by the arrows.

For example, Hata teaches positioning components in one direction only with motors 47 (see col. 7, lines 30-47). Also, Hata teaches positioning of the components in two directions, X and Y) simultaneously based on the simultaneous operation of both motors 47 and motors 56 (see col. 7, line 63 to col. 8, line 17). Furthermore, the controller 100 of Hata enables positioning or moving of the components exclusively simultaneously in one direction and also independently

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in another direction, based on the simultaneous or independent operation of the sets of motors 47, 56 (see Fig. 5).

While Hata fully meets the function of the “wherein...” clause (last 3 lines of Claim 1) as explained above, the examiner reiterates that claims directed to an apparatus or machine may be recited either structurally or functionally. However, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). So the examiner **again**, poses the following question to the applicant. How does this “wherein...” clause further limit the structure of the machine?

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599.

The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

October 28, 2004